

REMARKS

In the Office Action, claims 21-24 were rejected. More specifically,

- Claims 21-24 were rejected under 35 U.S.C. §§ 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious in view of the publication to Marois et al. ("Marois"); and

By this Amendment, claim 21 has been amended. Applicants do not believe that any new matter is introduced by this Amendment, and submit that support for the claim amendment may be found throughout the specification as filed. Upon entry of this Amendment, claims 21-31 are pending, of which claims 25-31 are withdrawn. For the reasons set forth hereinbelow, Applicants traverse the rejections and respectfully request that the rejections of the claims be withdrawn.

§102/103 Rejections Based on Marois

Claims 21-24

The Examiner rejects claims 21-24 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Marois. It is respectfully submitted that the Examiner has inappropriately assumed that the strains disclosed in Marois et al. are inherently the same as those disclosed and claimed in the present application. Additionally, the presently claimed strain displays unexpected properties when compared to Marois et al. and is thus non-obvious over Marois et al.

Talaromyces sp. B-422 is capable of controlling seed-borne diseases of Gramineous plants, while Marois only discloses that *Talaromyces flavus* is capable of controlling verticillium wilt of eggplant. Verticillium wilt of eggplant is a kind of soil-borne disease which infects plants

through soil and is totally different in infection route and mechanisms of outbreak from seed-borne diseases.

Thus, Marois does not teach or suggest that *Talaromyces* controls not only soil-borne disease, but also seed-borne diseases. In that sense, the presently amended claims include a limitation not disclosed in Marois. As the Examiner is aware, a claim is anticipated by a prior art reference if, and only if, each and every claim limitation may be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131.01. It is respectfully submitted that the cited reference does not satisfy this requirement. Accordingly, the rejection of the present claims under § 102 are inappropriate. Reconsideration and withdrawal of these rejections are respectfully requested.

With respect to the §103 rejections, Applicants submit that independent claim 21 is nonobvious in view of Marois. In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. See MPEP § 2141.

Applicants submit that the differences between the Marois and the claimed invention are **substantial**, and that when the invention recited in claim 21 is considered as a whole, the invention recited in claim 21 is nonobvious in view of Marois. See MPEP § 2141.02. The fact that Marois fails to disclose, teach or suggest that *Talaromyces* controls not only soil-borne disease, but also seed-borne diseases supports a finding that claim 21 is nonobvious in view of Marois. Furthermore, one skilled in the art would not think that *Talaromyces* that is capable of

controlling soil-borne diseases would also control seed-borne diseases. In its presently amended form, Claim 21 recites limitations that are not taught or suggested by Marois. As the Examiner is aware, to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested in the cited references. MPEP § 2143.01. It is submitted that Marois does not satisfy this requirement in the claims as presently amended.

Therefore, Applicants submit that claim 21 is nonobvious in view of Marois. Applicants further submit that claims 22-24, which depend from claim 21, are also nonobvious in view of Marois. *See* MPEP §2143.03.

In view of the foregoing, Applicants respectfully request that the §102 and §103 rejections based on Marois. be withdrawn.

CONCLUSION

Applicants respectfully request a Notice of Allowance for claims 21-24 in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: December 14, 2010

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